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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77600844
Applicant	Zurich Insurance Company Ltd.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Trademark Examining Attorney : Andrea Koyner Nadelman  
Law Office: : 110  
Applicant/Appellant : Zurich Insurance Company Ltd  
Mark : ZURICH VIRTUAL CONCIERGE  
Application Serial No. : 77/600,844  
Filing Date : October 27, 2007  
Attorney Docket No. : 287740-00568

**BRIEF ON APPEAL**

Eckert Seamans Cherin & Mellott, LLC  
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600 Grant Street, 44<sup>th</sup> Floor  
Pittsburgh, Pennsylvania

July 2, 2010

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Sir:

This is an appeal from the Trademark Examining Attorney's final Office  
Action, dated August 17, 2009.

The only issue in this appeal is the Trademark Examining Attorney's Section 2(d) refusal of Applicant's mark based on United States Trademark Registration No. 3,089,727.

Applicant's mark, "ZURICH VIRTUAL CONCIERGE," is proposed to be used on the following services:

Providing financial risk management information and insurance information via emails, personalized websites and electronic press releases and announcements

Registrant's mark is "VIRTUAL CONCIERGE" and is registered for business management consulting services. Registrant's website, [www.thevirtualconcierge.com](http://www.thevirtualconcierge.com) (which is of record) indicates that Registrant provides concierge services, such as running errands for employees, for its customer companies.

The marks, when compared in their entireties, are different in pronunciation, commercial impression, and meaning. Applicant's use of its famous "ZURICH" mark (which has been recognized as having acquired distinctiveness by the Trademark Examining Attorney based on her acceptance of Applicant's Section 2(f) claim) distinguishes Applicant's mark from Registrant's. Applicant believes, contrary to the Trademark Examining Attorney, that the term "ZURICH" is dominant in the mark, as Applicant's service relates to insurance, which is where Applicant's mark has strong goodwill and recognition. While it is true, in general, that adding a term to a registered mark will not prevent confusion (see cases cited by the Trademark Examining Attorney), this case is different due to the strength, recognition, and dominance of the mark "ZURICH" in the insurance field and because the common term "VIRTUAL CONCIERGE" are somewhat weak and descriptive.

As evidence of the weakness of the term "VIRTUAL CONCIERGE," Applicant has, in fact, disclaimed "VIRTUAL." That term is certainly weak and diluted in this day and age when referring to services provided over a computer. As for the term "CONCIERGE," frankly, this term is descriptive of Registrant's services and would most certainly have been required to be disclaimed if Registrant would have properly recited what its actual services were (as evidenced by the description of its services as advertised on its website). As further evidence of the weakness of the term "VIRTUAL

CONCIERGE,” Applicant made of record United States Service Mark Registration No. 3,190,428.

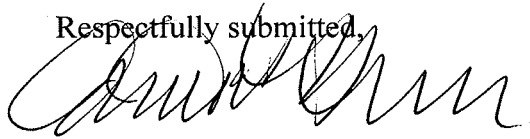
Based on the above, the addition to Applicant’s strong house mark, “ZURICH,” to the admittedly weaker and diluted term “VIRTUAL CONCIERGE” means that the relevant consumers will focus on the dominant “ZURICH” term and not on the weaker “VIRTUAL CONCIERGE” term, thus, avoiding any likelihood of confusion between the marks.

Applicant’s services are unrelated to those of Registrant. Applicant is providing financial risk management information and insurance information via emails, personalized websites, and electronic press releases and announcements in International Class 036. This is obviously a service that is related to Applicant’s primary insurance business and will be recognized as such by consumers due to Applicant’s use of its distinctive and famous “ZURICH” mark. Registrant’s services are really concierge services that have nothing to do with financial risk management and insurance. Applicant’s attorney realizes that Registrant’s mark is registered for “business management consulting services” and that, even given this is really misdescriptive of Registrant’s services, this service recital must be taken at face value. Even then, however, it is submitted that Applicant’s services are unrelated to business management consulting services, in that Applicant is providing financial risk management and insurance information and providing this service via the internet. Traditionally, business management consulting services do not necessarily involve financial risk management and insurance information, and those services are provided in person, much like medical and legal services.

Further, the circumstances surrounding the marketing of the respective services would not lead consumers to believe that these services emanated from a single source. Applicant’s services are related to Applicant’s insurance and risk management businesses and are delivered via the internet to sophisticated business people. Registrant’s services are also provided to sophisticated purchasers who will realize that their insurers, such as Applicant, are distinct from those providing business management consulting services (actually concierge services).

Based on the differences between the marks in their entireties, the unrelatedness of the services, and the differences in the way each parties' services are marketed, it is respectfully submitted that Applicant's mark, as applied to its services, is not likely to be confused with Registrant's mark, as applied to its services. The Trademark Examining Attorney's Section 2(d) refusal should be reversed by this Board and the application remanded to the Trademark Examining Attorney for her to allow the application and pass the mark to publication. Such actions are respectfully requested at an early date.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David V. Radack', written in a cursive style.

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